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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/815,344	04/01/2004	Steve Zulloff	502-P-008	8285

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EXAMINER

MILLER, BENA B

ART UNIT	PAPER NUMBER
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3714

DATE MAILED: 05/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/815,344

Applicant(s)

ZULOFF, STEVE

Examiner

Bena Miller

Art Unit

3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13, 18-33 is/are rejected.
- 7) ☒ Claim(s) 14-17 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 21-31 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims provide the method of providing at least one glowing projectile for expulsion from a toy gun, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-14, 17, 19-28, 31 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fusi et al (US Patent 5,415,151) in view of Applicant's Admission of Prior Art (herein AAPA).

Fusi et al teach in the figures most of the elements of the disclosed invention including a disk projectile (col. 4, line 1) and foam projectile (col. 4, par. 2; It should be noted that the Examiner takes the position that the supplying and storing means of Fusi

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et al is removably attachable to the body.) . Fusi et al also teach that the projectile is exposed to radiation of near UV to visible wavelengths; that the phosphor will respond to radiation of a given wavelength, generally radiation in the near ultraviolet to visible is appropriate (col. 2, lines 46-49 and col. 7, par. 2). Applicant admits on page 1, par [002] of the disclosed specification, that "the longer wavelengths of the ultraviolet lights spectrum are called black light, which have wavelengths slightly shorter than those that are normally visible and is generally safe for human viewing. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use black light as disclosed by AAPA for the device of Fusi et al for the purpose of allowing the projectile to phosphoresce as it leaves the projectile. It should be noted that the Examiner considers the structurally elements of claims 21-31 are inherent in the device of Fusi et al.

Fusi et al does not disclose expressly fluorescent pigment.

At the time the invention was made, it would have been an obvious matter of design choice to a persons of ordinary skill in the art to have a fluorescent pigment projectile because Applicant has not disclosed that the projectile is a fluorescent pigment provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Fusi et al toy gun and applicant's invention, to perform equally well.

Therefore, it would have been prima facie obvious to modify Fusi et al to obtain the invention specified in claims 1 and 20 because such modification would have been

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considered a mere design consideration which fails to patentably distinguish over the prior art of Fusi et al.

Claims 18 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fusi et al (US Patent 5,415,151) in view of Applicant's Admission of Prior Art (herein AAPA) as applied to claims 1 and 20 above, and further in view of Hornsby et al (US Patent 6,648,726).

Fusi et al and AAPA teaches in the figures most of the elements of the claimed invention, except sound. Hornsby teaches in the figures a toy gun having sound (col. 7, line 14) located therein. It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate sound as taught by Hornsby in the device of Fusi and AAPA for the purpose of allowing the projectile to phosphoresce as it leaves the projectile.

#### ***Allowable Subject Matter***

Claims 14-17 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

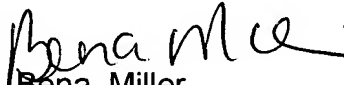
#### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bena Miller whose telephone number is 571.272.4427. The examiner can normally be reached on Monday-Friday.

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The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Bena Miller  
Primary Examiner  
Art Unit 3714

bbm  
May 10, 2005